

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Marvit, et al.  
Serial No.: 10/807,561  
Filing Date: March 23, 2004  
Confirmation No. 8346  
Group Art Unit: 2629  
Examiner: Regina Liang  
Title: *Selective Engagement of Motion Input Modes*

**Mail Stop Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

**REPLY BRIEF**

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer transmitted August 22, 2008. Appellants filed an Appeal Brief explaining clearly and in detail why the final rejections of Claims 1-20 are improper and should be reversed by the Board of Patent Appeals and Interferences. In the Examiner's Answer, the rejections are sustained.

**Argument**

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer transmitted August 22, 2008. Appellants filed an Appeal Brief explaining clearly and in detail why the final rejections of Claims 1-20 are improper and should be reversed by the Board of Patent Appeals and Interferences (the "Board"). In the Examiner's Answer, the rejections are sustained. The Examiner rejects Claims 1-20 as being unpatentable over U.S. Patent No. 5,598,187 to Ide et al ("*Ide*") in view of WO 01/86920 to Lapidot ("*Lapidot*").

In the Examiner's Answer, the Examiner responds to some of the arguments made by Appellants in the Appeal Brief with respect to the rejections indicated above. *See* Examiner's Answer, pages 6-7. Appellants reply to the Examiner's responses below.

**I. Appellants' Reply to Examiner's Responses Regarding the Impropriety of the Proposed Combination of *Ide* and *Lapidot***

The Examiner addresses Appellants' arguments that the proposed combination of *Ide* and *Lapidot* is improper. *See* Examiner's Answer, pages 6-7. The Examiner references a portable hand-held remote controller of *Lapidot* and suggests it would be obvious to modify the handheld device of *Ide* to have a display as taught by *Lapidot*. The Examiner calls Appellants' points that *Ide* teaches away from this combination misleading and not persuasive because the mouse of *Ide* is not a conventional mouse since "it also controls multi functions of a multimedia TV or a computer." Examiner's Answer, page 7. However, despite these teachings in *Ide*, Appellants' contention that *Ide* teaches away from a combination with *Lapidot* is still valid.

As Appellants pointed out, even if *Lapidot* does provide for a display on a hand-held device, *Ide* clearly teaches away from any combination that places a display on its spatial control device as described in *Ide* because, as described in *Ide*, the spatial control device is used to move a cursor on a screen. As *Ide* states, "the operator moves the mouse on the desk to move the cursor interlocking with the mouse movement to the desired object . . . appearing on the display. With the cursor positioned over the desired object on the display, he clicks (or releases) an acknowledge switch called a click button of the mouse to enter data to the

system." *Ide*, col. 1, lines 21-28. Thus, when using the mouse, the user watches the screen to track the movement of the cursor while the user's hand is on the mouse. There is therefore no motivation to include a viewable display on an input device as described by *Ide*, and the cited references teach away from such a combination.

The Examiner argues otherwise because:

*Ide*'s "spatial control mouse" not only controls the cursor on a screen of a PC (Fig. 3), it also controls multi functions of a multimedia TV or a computer (e.g., see Figs. 12, 17, 33). Clearly, *Ide*'s "spatial control mouse" is a multi-functions handheld remote controller and not just a mouse as erroneously alleged by appellant.

Examiner's Answer, page 7. However, despite the fact that *Ide* discloses that its mouse can control a television and other devices, the mouse is ***still operating in the conventional manner*** in this disclosure with respect to the way it controls a cursor on those devices. For example, Figure 12 of *Ide* discloses a multimedia television controlled by the mouse. *Ide* discloses here that the mouse is still controlling a cursor on screen 122 of the television:

[W]hen the operator presses the cursor button 114 of the mouse with his first finger (e.g., the thumb), a cursor appears on the screen 122. Moving the mouse body 111, the operator moves the cursor to an object to be clicked. Then, he presses the click button 117 with his second finger (e.g., the index finger or the middle finger).

Using the screen examples of FIGS. 13A to 13D, an example of operating the spatial control image system will be described. It is assumed that the contents of channel A are displayed on the screen. The state in such a screen is shown in FIG. 13A. For instance, when the operator wants to see channel D on the screen, he first clicks the cursor button 114. Then, an input screen 124 appears as shown in FIG. 13B. At this time, characters A to F indicating channels appear on the input screen 124. The current channel A is enclosed by a square cursor. The operator moves the mouse to move the cursor to character D as shown in FIG. 13C. Thereafter, he presses the click button 117 and then the cursor button 114. Then, the channel is changed as shown in FIG. 13D, and the input screen 124 disappears.

Such an operation can be applied to various actions such as volume control or hue adjustment, in addition to channel selection. As described above, use of the spatial control mouse of the invention allows the operator to perform an input operation ***while watching the television screen*** differently from when a conventional button-operated infrared remote-control device with many function keys is used. Thus, the operator is freed from memorizing the functions of many buttons and troublesome button operations. Namely, the spatial control mouse provides a very easy operation environment for the operator to use.

*Ide*, Figures 12, 13A, 13B, 13C, 13D and col. 11, lines 8-45 (emphasis added). Thus, the device being controlled in this case still has a screen to view to control the device with the mouse thereby teaching away from any need for a display on the mouse.

Similarly, Figure 17 of *Ide* cited by the Examiner discloses a display unit 202 with a screen 203 that is viewed to control the display unit with the mouse:

For example, the function shown in FIG. 17 can be realized. FIG. 17 shows an example of an input operation using a spatial motion pattern of the invention. As shown in the figure, the operator can move the spatial control mouse 1 from a to b and to c in a triangle to select a triangle item from the choices displayed on the screen 203 of a display unit 202.

*Ide*, Figure 17 and col. 16, lines 13-22.

Finally, Figure 33 of *Ide* cited by the Examiner also discloses a screen 203 on a display unit 202 to be viewed while using the mouse:

FIG. 33 shows a method of inputting motion patterns in three-dimensional movements. The operator can draw a triangular pyramid on the screen 203 of a display unit 202 by moving the mouse 1 in a triangular pyramid, starting with a, and passing through b, c, c, e, and f in that order.

*Ide*, Figure 33 and col. 22, lines 6-10.

Thus, *Ide* discloses a mouse controlling various devices with screens that the user of the mouse can view to perform the control, such as moving a cursor around the screen. *Ide*'s disclosure clearly teaches away from a combination with *Lapidot* that would place a display on the mouse because there is no motivation to do so.

Therefore, as indicated in the Appeal Brief, Appellants respectfully submit that the proposed combination of *Ide* and *Lapidot* is improper and request that the Board overturn the rejections of Claims 1, 10, 16, and 20 and all claims depending therefrom.

## **II. Appellants' Reply to Examiner's Responses regarding Claims 3-4, 6, 8, and 12-13**

In response to Appellants' arguments that Claims 3-4, 6, 8, and 12-13 are patentable over the combination of *Ide* and *Lapidot*, the Examiner merely states that "Appellant's remarks regarding dependent claims on pages 18-19 are not persuasive, see the rejection

above." Examiner's Answer, page 7. Thus, the Examiner provides no substantive answer to Appellants' arguments. However, as stated in Appellants' Appeal Brief, these claims are patentable over the *Ide-Lapidot* combination.

Claims 3 and 12

Claim 3 (which depends from Claim 2) recites that the mode selection trigger comprises a change in a state of the device and that "the change in the state of the device occurs when the device switches from a first application to a second application." Claim 12 recites similar elements. In addition to being allowable for depending from Claim 1 discussed above with respect to the improper *Ide-Lapidot* combination, the Office Action merely cites to Figure 1 and Figure 16 of *Ide* as disclosing these elements. See Office Action, pp. 4-5. However, neither these figures, their related description, nor any other portion of *Ide* discloses that a switch from a first application to a second application is a mode selection trigger that triggers the switch between the first mode of motion input operation and the second mode of motion input operation. *Ide* only discloses that the switching between its pointer function and motion pattern input function "may be set on the mouse side or specified on the control target device side" or by pressing a "motion input start button." *Ide*, col. 15, lines 39-42 and col. 22, lines 28-32. There is ***no disclosure*** that ***a switch from a first application to a second application triggers the change in motion input modes***. Therefore, for at least this additional reason, Appellants respectfully submit that Claims 3 and 12 are patentable over the cited art used in the rejections and request that the Board overturn these rejections.

Claims 4 and 13

Claim 4 (which depends from Claim 2) recites that the mode selection trigger comprises a change in a state of the device and that "the change in the state of the device occurs when the current image switches from a first image to a second image." Claim 13 recites similar elements. These claims are allowable for depending from Claim 1 discussed above with respect to the improper *Ide-Lapidot* combination. In addition, as indicated above in the discussion of Claims 3 and 12, *Ide* merely discloses that the switching between its pointer function and motion pattern input function may be set on the mouse side or specified on the control target device side or by pressing a motion input start button. See *Ide*, col. 15,

lines 39-42 and col. 22, lines 28-32. There is ***no disclosure*** that ***a switch from a first image to a second image triggers the change in motion input modes***. Therefore, for at least this additional reason, Appellants respectfully submit that Claims 4 and 13 are patentable over the cited art used in the rejections and request that the Board overturn these rejections.

Claim 6

Claim 6 recites that the mode selection trigger comprises one of the gestures. This claim is allowable for depending from Claim 1 discussed above with respect to the improper *Ide-Lapidot* combination. In addition, the Office Action cites to column 22, lines 31-32 of *Ide* as disclosing this element. *See* Office Action, page 4. However, this cited portion merely discloses the operation of changing from a pointer function to a motion input function as placing the cursor in a certain position, pressing a motion input start button, and making predetermined simple movements such as waving up and down several times. *See Ide*, col. 22, lines 28-32. There is ***no disclosure*** of ***an actual gesture for triggering a switch in motion input modes***. Therefore, for at least this additional reason, Appellants respectfully submit that Claim 6 is patentable over the cited art used in the rejections and request that the Board overturn this rejection.

Claim 8

Claim 8 recites that the display control module has a third mode of operation "to disregard the motion of the device." This claim is allowable for depending from Claim 1 discussed above with respect to the improper *Ide-Lapidot* combination. In addition, the Office Action cites to portions of *Lapidot* as disclosing this element. *See* Office Action, page 4. However, to make the rejection of Claim 1, the Office Action relies on modifying *Ide* to place a display on the handheld device of *Ide*. *Ide* is solely directed to a "spatial control mouse" to control a cursor on, for example, a laptop or to control another device through motion. Having a mode of operation that ***disregards*** motion of the spatial control mouse of *Ide* ***clearly teaches away*** from *Ide*'s disclosure and would make *Ide* unsatisfactory for its intended purpose, which is to control equipment through motion input. Therefore, for at least this additional reason, Appellants respectfully submit that Claim 8 is patentable over the cited art used in the rejections and request that the Board overturn this rejection.

**Conclusion**

Appellants have demonstrated, through their Appeal Brief and this Reply Brief, that the claims are clearly distinguishable over the prior art used in the rejections. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the Examiner's final rejection of the pending claims and instruct the Examiner to issue a notice of allowance of all pending claims.

Appellants believe no fees are due in the filing of this Reply Brief. However, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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